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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,023	05/24/2001	Michael Aven	AM100307-00	2884

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WASHINGTON, DC 20036

EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/865,023

Applicant(s)
Aven et al

Examiner
S. Mark Clardy

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 8, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19 is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, and 10-14 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Claims 1 and 3-19 are pending in this application for which a Request for Continued Examination (RCE) and supplemental IDS has been filed following a Notice of Allowance mailed May 6, 2002. The application claims the benefit under 35 USC 119(e) of US Provisional Application No. 60/213,819, filed June 23, 2000, and 60/222,535, filed August 2, 2000.

Applicants' claims are drawn to solid granular herbicidal compositions (claims 8-11) which either comprises:

- A. 1) an aryloxypyrimidine or aryloxypyridine derivative (Claim 4: picolinafen¹, "TTP"² formula IA), and
- 2) a solid carrier (gypsum, clays, polyvinylpyrrolidone, polyvinylacetate, cyclodextrin (see claim 9), sugar, mixtures/copolymers, and optional solid auxiliaries);

or consists essentially of:

- B. 1) diflufenican³ (claim 15), and
- 2) cyclodextrin of formula II (claim 15).

Also claimed are methods of enhancing the herbicidal efficacy of the pyrimidine/pyridine by formulating them in solid form (claims 1, 3-7) and herbicidal methods of use (claims 12-13). The formulation methods include mixture of the above with a second herbicidal agent (claim 7; 122 secondary herbicides listed). Diflufenican is limited to claims 15-19.

¹N-(4-fluorophenyl)-6-[3-trifluoromethylphenoxy]-2-pyridine carboxamide

²4-(3-trifluoromethylphenoxy)-2-(4-trifluoromethylphenyl)pyrimidine

³2',4'-difluoro-2-(α,α,α -trifluoro-m-tolyloxy)-nicotinamide

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Claims 15-19 are allowable over the cited prior art. No references have been found with teach or suggest the combination of diflufenican with cyclodextrin in a solid composition.

Claim 9 is objected to as being dependent upon a rejected base claim (see below), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, below, and to include all of the limitations of the base claim and any intervening claim

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 11 recite the limitation "cyclodextrin of formula II" in line 2 of each claim. There is insufficient antecedent basis for this limitation in the claim. Formula II occurs in claim 9, rather than in claim 8, from which claims 10 and 11 directly depend.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-8, 12-14 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by either Mayer et al (US 6,030,924) or Maier et al (US 6,448,204).

Mayer et al teach solid herbicidal formulations comprising various active agents including diflufenican (col 3, line 29) and, preferably, picolinafen (lines 48-53). Conventional fillers may be used in the compositions such as kaolin and other clay mineral materials (col 7, lines 30-39). Solid granular picolinafen compositions, with kaolin as a solid carrier, are described in Examples 3 and 4. While applicants compositions are described as having enhanced herbicidal activity due to the solid carrier, this characteristic would appear to be inherent in the compositions of Mayer et al.

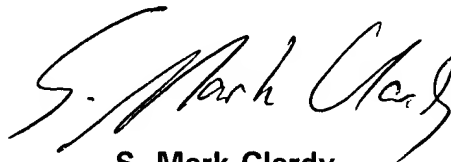
Maier et al teach herbicidal pyrazolylpyridine compositions comprising active agents within the scope of applicants' claims, in combination with solid carriers (col 8, lines 10-19). Note that the use of a carrier which will provide slow release of the pesticidal compounds into the environment of a plant which is to be protected is of "particular interest in enhancing the duration of the protective activity of the compounds of this invention" (col 9, lines 8-13). Examples are provided for a wettable powder (WP) and a water dispersible granule (WG) composition (columns 9-10). Further, the active agents may be combined with various secondary herbicidal agents (columns 10-11), and are useful for various weeds including *Galium aparine* and *Alopecurus myosuroides* (col 12,

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Table 1). Here, as in Mayer et al, above, it would appear that applicants' property of enhanced herbicidal activity would be inherent in the compositions of Mayer et al.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



S. Mark Clardy
Primary Examiner
AU 1616

December 4, 2002